

## REMARKS

Claims 1-50 were pending in this application. In the Office Action<sup>1</sup>, the Examiner objected to the specification because an Abstract was not included. Accordingly, attached hereto, Applicants submit an Abstract on a separate sheet.

The Examiner rejected claims 1-50 under § 112, second paragraph, as being indefinite. Accordingly, Applicants have amended claims 1, 9, 19, 27, and 37 and canceled claims 10, 28, and 44 in accordance with the Examiner's suggestions, in order to more appropriately claim the subject matter of the invention.

The Examiner rejected claims 1-7, 12, 14, 17-26, 30, 32, 35, 36, 38-40, 42, and 50 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,108,420 to Larose et al. ("*Larose*"); and rejected claims 8 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Larose* in view of U.S. Patent No. 4,908,861 to Brachtl et al. ("*Brachtl*").

The Examiner also rejected claims 1-5, 13-16, 19-23, 31-34, 37-40, and 47-49 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,009,401 to Horstmann ("*Horstmann*"); rejected claims 1, 6, 12, 19, 24, 30, and 37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,790,664 to Coley et al. ("*Coley*"); rejected claims 8 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Larose*, in view of *Brachtl*; rejected claims 17, 18, 35, 36, and 50 under 35 U.S.C. § 103(a) as being *Horstmann* in view of *Official Notice*; rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Horstmann* in view of *Larose*; and rejected claims 7-11, 25-

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

29, and 41-45 under 35 U.S.C. § 103(a) as being unpatentable over *Coley* in view of U.S. Patent No. 5,787,174 to Tuttle ("*Tuttle*").

In the application, claims 1-4, 6-9, 11-22, 24-27, 29-39, 41-43, 45-50, and new claims 51-53 are currently pending. In view of the foregoing amendments and the following remarks, Applicants respectfully traverse the Examiner's rejections of the claims under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a).

### **§ 102(e) Rejections**

In order to properly anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in...the claim." See M.P.E.P. 2131 (8<sup>th</sup> Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. 2131 (8<sup>th</sup> ed., 2001), p. 2100-69.

As noted above, the Examiner rejected claims 1-7, 12, 14, 17-26, 30, 32, 35, 36, 38-40, 42, and 50 under § 102(e) as being anticipated by *Larose*, claims 1-5, 13-16, 19-23, 31-34, 37-40, and 47-49 under § 102(e) as being anticipated by *Horstmann*, and claims 1, 6, 12, 19, 24, 30, and 37 under § 102(e) as being anticipated by *Coley*. With respect to claim 1, the Examiner alleged that *Larose* discloses: "files present on an installation computer, and examining the files and embedded data, sending a license-specific portion which is evaluated by a server, and processing the digital content subject to the status (e.g. upgrade)" (OA at page 3, ¶ 10).

Applicant respectfully submits that *Larose* does not suggest or teach the combination of steps recited in amended claim 1. For example, *Larose* does not disclose “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1.

*Larose* discloses a method and system for networked installation of uniquely customized, authenticable, and traceable software application (title). *Larose* provides for a user installation agent resident on an installation computer to request software application from a distribution server, and the distribution server embeds a unique data set in the desired software application before sending the software to the installation computer (figs. 1 and 7; col. 3, lines 27-40). Following installation of the software on the installation computer, the embedded data and cryptographic signature are used to provide a means to trace the software application to the user, to police the continued integrity of the software application, to ensure that license conditions continue to be met, to perform virus checking, or automatic upgrading of the software application itself (col. 3, lines 50-56).

In contrast, claim 1 recites the step of “examining the digital content to identify data indicating that the content is ***subject to a first license and a second license***, wherein the data includes licensing information, and wherein ***the first license corresponds to a first entity and the second license corresponds to a second entity***.” *Larose* teaches embedding a unique data set in the desired software application before sending the software to the installation computer. The use of a

unique data set in the desired software application in *Larose* is not sufficient to constitute the aforementioned “examining,” as recited in amended claim 1.

For at least the foregoing reasons, Applicant submits that the rejection of claim 1 is unsupported by *Larose*. Because claims 19 and 37 are independent claims with limitations similar to those of claim 1, Applicant further submits that the rejections of claims 19 and 37 are not supported by *Larose*, for at least the reasons given with respect to independent claim 1. The rejections of dependent claims 2-4, 6, 7, 12, 14, 17, 18, 20-22, 24-26, 30, 32, 35, 36, 38, 39, 42, and 50 are unsupportable for the reasons stated above with regard to their respective allowable base claims.

Regarding claim 1, the Examiner alleged that *Horstmann* discloses: “software installation that includes a license certificate stored on a user machine” that checks the license terms and trial parameters and allow a software trial (OA at page 4, ¶ 17). Applicant respectfully submits that *Horstmann* does not suggest or teach the combination of steps recited in amended claim 1.

*Horstmann* discloses a mechanism for relicensing electronically purchase software (title). *Horstmann* provides a mechanism for purchase documentation and allows for re-download and relicensing of software (fig. 1; col. 2 lines 59-63). The mechanism in *Horstmann* refers to a license certificate stored on the end user’s machine during installation and re-installation of software (col. 3, lines 12-17).

In contrast, claim 1 recites the step of “examining the digital content to identify data indicating that the content is ***subject to a first license and a second license***, wherein the data includes licensing information, and wherein ***the first license corresponds to a first entity and the second license corresponds to a second***

*entity.*” *Horstmann* teaches referring to a license certificate stored on the end user’s machine during installation and re-installation of software. The utilization of a license certificate stored on the end user’s machine in *Horstmann* is not sufficient to constitute the aforementioned “examining,” as recited in amended claim 1.

For at least the foregoing reasons, Applicant submits that the rejection of claim 1 is unsupported by *Horstmann*. Because claims 19 and 37 are independent claims with limitations similar to those of claim 1, Applicant further submits that the rejections of claims 19 and 37 are not supported by *Horstmann*, for at least the reasons given with respect to independent claim 1. The rejections of dependent claims 2-4, 13-16, 20-22, 31-34, 38, 39, and 47-49 are unsupportable for the reasons stated above with regard to their respective allowable base claims.

Further regarding claim 1, the Examiner alleged that *Coley* discloses: “client application (digital content) comprising a client module (data indicating that the content is subject to a license. It also includes IP address of the computer as discussed [sic] bellow) that sends enquiry to a license server (col. 4 lines 22-32). Upon receipt of the license record the application is enabled (col. 4 lines 44-46)” (OA at page 4, ¶ 17). The Examiner further alleged that “*Coley et al.* teach a license record identifying a license in accordance with a hardware identifier such as an IP address (col. 4 lines 30-33) and the request message containing information such as the application information and a hardware identifier, such as the IP address of the computer (portion of the data indicating that the content is subject to a license) (col. 9 lines 3-8)” (OA at page 4, ¶ 17). Applicant respectfully submits that *Coley* does not suggest or teach the combination of steps recited in amended claim 1.

*Coley* discloses an automated system for management of license software (title). For licensing validation, *Coley* provides a client module in a client application forming and communicating a license validity inquiry with a licensing server (fig. 2; col. 8 line 54-col. 9 line ). The license validity inquiry may contain information such as the application name, the application version number, a date/time stamp, the name of a license server, and hardware identifier, such as the IP address of the computer (col. 9, lines 4-7).

In contrast, claim 1 recites the step of “examining the digital content to identify data indicating that the content is ***subject to a first license and a second license***, wherein the data includes licensing information, and wherein ***the first license corresponds to a first entity and the second license corresponds to a second entity.***” *Coley* teaches forming and communicating a license validity inquiry with a licensing server. The license validity inquiry to the license server in *Coley* is not sufficient to constitute the aforementioned “examining,” as recited in amended claim 1.

For at least the foregoing reasons, Applicant submits that the rejection of claim 1 is unsupported by *Coley*. Because claims 19 and 37 are independent claims with limitations similar to those of claim 1, Applicant further submits that the rejections of claims 19 and 37 are not supported by *Coley*, for at least the reasons given with respect to independent claim 1. The rejections of dependent claims 6, 12, 24, and 30 are unsupportable for the reasons stated above with regard to their respective allowable base claims.

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner to reconsider and withdraw the rejection of claims 1-7, 12, 14, 17-26, 30, 32, 35, 36, 38-40, 42, and 50 under § 102(e) as being anticipated by *Larose*,

claims 1-5, 13-16, 19-23, 31-34, 37-40, and 47-49 under § 102(e) as being anticipated by *Horstmann*, and claims 1, 6, 12, 19, 24, 30, and 37 under § 102(e) as being anticipated by *Coley*.

### **§ 103(a) Rejections**

To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference as modified must teach or suggest all the claim elements. (See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001)). Second, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. (See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001)). Third a reasonable expectation of success must exist. Moreover, each of these requirement must “be found in the prior art, and not be based on applicant’s disclosure.” (M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001)).

As noted above, the Examiner rejected claims 8 and 26 under 35 U.S.C. § 103(a) as being unpatentable over *Larose* in view of *BrachtI*, claims 17, 18, 35, 36, and 50 under 35 U.S.C. § 103(a) as being *Horstmann* in view of *Official Notice*, claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Horstmann* in view of *Larose*, and claims 7-11, 25-29, and 41-45 under 35 U.S.C. § 103(a) as being unpatentable over *Coley* in view of *Tuttle*.

Claims 8 and 26 depend on amended claims 1 and 19, respectively, and thus require all elements of their respective base claims. Applicant respectfully submits that *Larose* in view of *BrachtI* does not suggest or teach the combination of steps recited in claim 1. As discussed above, *Larose* does not disclose at least “examining the digital content to identify data indicating that the content is subject to a first license and a

second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1.

*Brachtl* is not sufficient to make up for the deficiencies of *Larose*. *Brachtl* discloses a cryptographic method and apparatus to “transform a message of arbitrary length into a block of fixed length (128 bits)” (col. 1 lines 61-65). *Brachtl* teaches sending an encrypted portion of the message (fig. 1; col. 3 line 54-col. 4 line 9). However, *Brachtl* does not disclose “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1. Moreover, a combination of *Larose* and *Brachtl* fails to teach “examining” as recited in amended claim 1.

For at least this reason, a prima facie case of obviousness has not been established with respect to amended claim 1. Because claim 19 is an independent claim with limitations similar to those of claim 1, Applicant further submits that the rejection of claim 19 is not supported by *Larose* in view of *Brachtl*, for at least the reasons given with respect to independent claim 1. The rejections of dependent claims 8 and 26 are unsupportable for the reasons stated above with regard to their respective allowable base claims.

Claims 17, 18, 35, 36, and 50 depend on amended claims 1, 1, 19, 19, and 37 respectively. Applicant respectfully submits that *Horstmann* in view of *Official Notice* does not suggest or teach the combination of steps recited in claim 1. As discussed



above, *Horstmann* does not disclose at least “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1.

Examiner’s *Official Notice* is not sufficient to make up for the deficiencies of *Horstmann*. Examiner asserts that “it is old and well-known that license can be restricted to commercial or non-commercial use and based on the restriction the licensed material may be utilized differently” (OA at page 6, ¶ 31). However, even if the Examiner is correct, such assertion does not constitute “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1. Moreover, a combination of *Horstmann* and *Official Notice* fails to teach “examining” as recited in amended claim 1.

For at least this reason, a *prima facie* case of obviousness has not been established with respect to amended claim 1. Because claims 19 and 37 are independent claims with limitations similar to those of claim 1, Applicant further submits that the rejections of claims 19 and 37 are not supported by *Horstmann* in view of *Official Notice*, for at least the reasons given with respect to independent claim 1. The rejections of dependent claims 17, 18, 35, 36, and 50 are unsupportable for the reasons stated above with regard to their respective allowable base claims.

Claim 14 depends on amended claim 1. Applicant respectfully submits that *Horstmann* in view of *Larose* does not suggest or teach the combination of steps recited in claim 1. As discussed above, neither *Horstmann* nor *Larose* disclose “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1. *Horstmann* and *Larose* therefore fail, either alone or in combination, to disclose each and every element as recited in amended claim 1. For at least this reason, a prima facie case of obviousness has not been established with respect to amended claim 1. The rejection of dependent claim 14 is unsupportable for the reasons stated above with regard to its allowable base claim.

Claims 7-11, 25-29, and 41-45 depend on amended claims 1, 19, and 37, respectively. Applicant respectfully submits that *Coley* in view of *Tuttle* does not suggest or teach the combination of steps recited in claim 1. As discussed above, *Coley* does not disclose “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1.

*Tuttle* is not sufficient to make up for the deficiencies of *Coley*. *Tuttle* discloses a integrated circuit that may be remotely tracked, located, and identified (col. 1 lines 61-63). *Tuttle* teaches encrypting the identifier of the integrated circuit (col. 5 line 24-40). However, *Tuttle* does not disclose “examining the digital content to identify data indicating that the content is subject to a first license and a second license, wherein the

data includes licensing information, and wherein the first license corresponds to a first entity and the second license corresponds to a second entity,” as recited in amended claim 1. Moreover, a combination of *Coley* and *Tuttle* fails to teach “examining” as recited in amended claim 1.

For at least this reason, a prima facie case of obviousness has not been established with respect to amended claim 1. Because claim 19 and 37 are independent claims with limitations similar to those of claim 1, Applicant further submits that the rejections of claims 19 and 37 are not supported by *Coley* in view of *Tuttle*, for at least the reasons given with respect to independent claim 1. The rejections of dependent claims 7-11, 25-29, and 41-45 are unsupportable for the reasons stated above with regard to their respective allowable base claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 28, 2005

By: 

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**Attachments:      Abstract**